

Application No.: 09/601434

Docket No.: 09931-00009-US

REMARKS

Applicant respectfully request reconsideration in view of the following remarks. Claims 21 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lupo et al. (English version of EP 0676461 A2) ("Lupo"). Claims 25-26 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupo in view of Suzuki et al. U.S. Patent No. 3,523,045. The applicant respectfully traverses these rejections.

The applicant appreciates that the Examiner has acknowledged that claims 29 and 33-35 are allowable.

The instant invention is rejected as anticipated by the Lupo (EP-A-676 461 which corresponds to US-A-5 ,840,217). Reading both Lupo documents (the EP and US) again carefully, the applicant is not able to find a disclosure in anywhere in of the EP document or the US counterpart which mentions "laser", let alone on page 38, lines 8-27 of EP. The applicant respectfully requests that the Examiner point out the specific page and line number that refers to laser.

Furthermore, the Examiner states on page 3 of the Office Action with respect to claims 25-26 and 31-32, "Lupo discloses all limitations of the claim except for the light source being a laser." Therefore, the Examiner agrees that Lupo does not disclose a laser. For the above reason, the applicant does not believe that Lupo anticipates the claimed invention.

Suzuki discloses gallium arsenide injection laser diode comprising a GaAs substrated doped with zinc and having a net acceptor impurity concentration... (see col. 1, lines 12-20). Suzuki is not even remotely related to the applicant's claimed invention.

With respect to the 103 rejection, the Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose

402416_1

Application No.: 09/601434

Docket No.: 09931-00009-US

from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Lupo in view of Suzuki.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

OCT. 17. 2005 4:27PM

NO. 8329 P. 7

Application No.: 09/601434

Docket No.: 09931-00009-US

A one month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 09931-00009-US from which the undersigned is authorized to draw.

Respectfully submitted,

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